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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/769,718

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EXAMINER

WONG, ERIC TAK WAI

ART UNIT

PAPER NUMBER

3693

MAIL DATE

DELIVERY MODE

09/29/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/769,718	Applicant(s) STEPHAN ET AL.	
	Examiner ERIC T. WONG	Art Unit 3693	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,8,17 and 33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,8,17 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Examiner's note: Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the **entire** reference as potentially teaching all or part of the claimed invention, as well as the content of the passage as taught by the prior art or disclosed by the Examiner.

2. Claims 1, 8, and 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah ("Consultant in a Box"), in view of Porter (as evidenced by attached "Value Chain" figure and Lai (US PG-Pub 2007/0198544 A1), see paragraph 2), further in view of Bushey (US Patent No. 6,389,400), further in view of Engleman (US PG-Pub 2003/0163357 A1).

3. Regarding claim 1, Cavanah teaches consulting software which collects and analyzes information and then subsequently generates reports. Cavanah does not teach the software using a value chain analysis model with evaluation categories comprising value chain steps and performance attributes (see figure). Porter teaches a value chain analysis model with evaluation categories comprising value chain steps and performance attributes (see Porter figure). The value chains steps include inbound logistics, operations, outbound logistics, marketing & sales, and service. The performance attributes include firm infrastructure, human resource management, technology development, and procurement. Therefore, it would have

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been obvious to one skilled in the art at the time of invention to modify the consulting software of Cavanah to incorporate a value chain analysis model as taught by Porter. One skilled in the art would have been motivated to make the modification because the value chain analysis model of Porter is a popular model to evaluate a business.

4. Porter does not teach assigning weights to the evaluation categories. Bushey teaches weighting performance attributes to determine their relative importance to one another (see column 1 lines 39-67). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify the software of Cavanah further so that the value chain analysis of Porter includes assigning weights to the evaluation categories. One skilled in the art would have been motivated to make the modification to determine the relative importance of the evaluation categories to one another.

5. Cavanah does not teach asking evaluation questions, wherein said evaluation questions comprise groups of questions organized within each of said value chain steps and wherein some of said evaluation questions within said value chain steps are directed to said performance attributes and are interspersed across said groups of questions. Engleman teaches asking a series of questions to departmental and functional managers to determine the relative importance of a functionality (evaluation category) of a business (see paragraphs 48-50). Therefore, it would have been obvious to modify the software of Cavanah further with collecting responses to evaluation questions and weightings by interviewing a portfolio management expert in order to determine the weightings. One skilled in the art would have been motivated to make the modification in order to determine the relative importance of the evaluation categories to one another.

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6. Claim 8 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah, in view of Porter, further in view of Bushey, further in view of Engleman, further in view of Lostis (US PG-Pub 2002/0026429).

7. Regarding claim 8, Porter does not explicitly teach a value tree analysis grouping said responses to said evaluation questions from different categories into measurement categories thereby combining said grouped responses into an effectivity result for each measurement category, said value tree analysis further comprising recommended solutions based on said effectivity result wherein weightings from said industry expert for each of said measurement categories are not input into said computer analysis tool, said value tree analysis further comprising recommended solutions based on said effectivity result. Lostis teaches multi-attribute decision analysis tools for value trees. These tools perform a value tree analysis grouping different categories into measurement categories to provide an effectiveness result (see [0165]). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify Porter further with including a value tree analysis grouping said responses to said evaluation questions from different categories into measurement categories thereby combining said grouped responses into an effectivity result for each measurement category, said value tree analysis further comprising recommended solutions based on said effectivity result. One skilled in the art would have been motivated to make the modification for the benefit of identifying the strategy most likely to reach a goal.

8. Claim 17 rejected under 35 U.S.C. 103(a) as being unpatentable over Cavanah, in view of Porter, further in view of Bushey, further in view of Engleman, further in view of Lostis, further

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in view of Peters (US PG-Pub 2003/0088489 A1), further in view of De Goeij (US PG-Pub 2003/0110070 A1).

9. Regarding claims 17 and 33, Porter does not teach the evaluation categories being categories of a portfolio management process including at least value chain steps comprising profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring. Peters teaches that portfolio management process comprises profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring. Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Cavanah further so that the value chains steps of the value chain analysis model of Porter include profile assessment, asset allocation, asset selection, order generation, and reporting and monitoring. The modification would have merely been the application of a known technique to a known method ready for improvement in order to yield predictable results, the predictable results being a horizontal analysis tailored to a portfolio management business, as opposed to any organization in general.

10. Porter does not teach performance attributes comprising automatization, scalability, and outsourcing and insourcing. De Goeij teaches considering automation, scalability, outsourcing, and insourcing when improving an organization (see paragraphs 1, 5, 49). Therefore, it would have been obvious to one skilled in the art at the time of invention to modify Cavanah further so that the performance attributes of the value chain analysis model of Porter include automation, scalability, outsourcing, and insourcing. The modification would have merely been the application of a known technique to a known method ready for improvement in order to yield predictable results, the predictable results being a vertical analysis tailored to a portfolio management business, as opposed to any organization in general.

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Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC T. WONG whose telephone number is 571-270-3405. The examiner can normally be reached on Monday-Friday 9:00AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James A. Kramer can be reached on 571-272-6783. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/James A. Kramer/
Supervisory Patent Examiner, Art Unit 3693

ERIC T. WONG
Examiner
Art Unit 3693

September 24, 2008